REMARKS

Administrative Overview

The Office action of April 21, 2006, examined claims 105-111, 113, 115-119, 121-126, 148, 150, 152-156, 159, 160, 162-168, 170, and 171.

I. The Office action rejects each of these claims under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 5,713,364 (**DeBaryshe**) in view of U.S. Patent No. 4,362,166 (**Furler**), 5,337,734 (**Saab**), or 6,115,523 (**Choi**).

II The Office action rejects claims 105-107, 109, 110, 115, 125, 126, 152-156, 159-160, 165-167, 170, and 171 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,424,852 (**Zavislan**) in view of **Furler**, **Saab**, or **Choi**.

III Finally, the Office action rejects claims 108, 111, 113, 118, 119, 121, 123, 148, 150, 162, and 168 under 35 U.S.C. 103(a) as allegedly being unpatentable over **Zavislan** in view of **Furler**, **Saab**, or **Choi**, and further in view of U.S. Patent No. 5,693,043 (**Kittrell**).

Responses to rejections I, II, and III are presented below. Applicants do not acquiesce to any of the Examiner's rejections. Although Applicants address each of the rejections of the Office Action, Applicants reserve the right to make additional arguments, should they become necessary.

I. Rejection of claims under 35 U.S.C. 103(a) over **DeBaryshe** in view of **Furler**, **Saab**, or **Choi** is improper

The present application claims priority to **DeBaryshe** (see Amendment and Response filed December 23, 2004). As explained in the Amendment and Response filed December 23, 2004, the present application shares common inventors with **DeBaryshe**, claims priority to **DeBaryshe**, and incorporates **DeBaryshe** by reference (see paragraph [0004] on page 1). Also, the present application and **DeBaryshe** are co-owned.

Furthermore, the priority claim was made within the time limit specified in 37 CFR 1.78 (a)(2)(ii), since the **DeBaryshe** application, and the applications in the chain from the present application to **DeBaryshe**, were specified by application number (series code and serial number) and filing date in the present application on April 24, 2001 (the filing date of the present application; see page 1, lines 4-6 and 27-29 of the originally-filed application).

Applicants submit a Supplemental Application Data Sheet herewith to reflect the priority claim. If, for any reason, it is believed that the claim of priority to **DeBaryshe** is insufficient or was made after the time limit specified in 37 CFR 1.78(a)(2)(ii), Applicants reserve the right to submit a petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 120, 121, or 365(c), along with the surcharge of 37 CFR 1.17(t).

Applicants contend that the effective filing date of each of the pending claims is the filing date of **DeBaryshe**. Thus, Applicants contend **DeBaryshe** cannot properly be used as prior art in a rejection under 35 U.S.C. 103(a), and Applicants request reconsideration and withdrawal of the rejections of claims 105-111, 113, 115-119, 121-126, 148, 150, 152-156, 159, 160, 162-168, 170, and 171 over **DeBaryshe** in view of **Furler**, **Saab**, or **Choi**.

II. **Zavislan** does not teach "sequentially scanning a plurality of substantially non-overlapping regions of an internal biological sample"

The Office action alleges, "**Zavislan** discloses an optical system for diagnosing tissue using an illuminating and detecting arrangement." However, this is not the language recited in the claims.

Each of independent claims 105 and 152 recites, "sequentially scanning a plurality of substantially non-overlapping regions of an *internal* biological sample" [emphasis added]. The Office action does not explain where **Zavislan** allegedly teaches or suggests this limitation.

Zavislan does not teach or suggest this limitation. For example, **Zavislan** appears to have nothing to do with "an internal biological sample", since it presents a system for imaging skin. Skin is an external organ, and is not an "internal biological sample". Applicants reserve the right to distinguish the claims from **Zavislan** on additional bases as well, should it become necessary.

None of the other references in the rejection – **Furler**, **Saab**, and **Choi** – are purported to teach or suggest "sequentially scanning a plurality of substantially non-overlapping regions of an internal biological sample".

Since the combined references teach fewer than all of the limitations of either claim 105 or claim 152, then claims 105 and 152 are patentable over the cited art. Applicants respectfully request reconsideration and withdrawal of the rejections of claims 105-107, 109, 110, 115, 125, 126, 152-156, 159-160, 165-167, 170, and 171 over **Zavislan** in view of **Furler** or **Saab** or **Choi**.

III. The third rejection of the Office Action does not involve independent claims 105 and 152.

Applicants traverse the rejection of claims 108, 111, 113, 118, 119, 121, 123, 148, 150, 162, and 168 under 35 U.S.C. 103(a) as allegedly being unpatentable over **Zavislan** in view of **Furler**, **Saab**, or **Choi**, and further in view of U.S. Patent No. 5,693,043 (**Kittrell**).

The Office Action does not allege that **Kittrell** teaches or suggests the limitation, "sequentially scanning a plurality of substantially non-overlapping regions of an internal biological sample", recited in each of claims 105 and 152. With regard to **Kittrell** the Office

Action alleges the following:

> Kittrell et al disclose a method of optically analyzing tissue. Kittrell et al disclose illuminating the tissue using an optical assembly comprising moveable mirrors to focus the light on different regions of tissue. The structure set forth in claim 118, 119 is seen in figure 23, elements 68, 70.

This does not speak to the limitation, "sequentially scanning a plurality of substantially non-overlapping regions of an internal biological sample", recited in each of claims 105 and 152.

Because each one of claims 108, 111, 113, 118, 119, 121, 123, 148, 150, 162, and 168 depends directly or indirectly from either claim 105 or 152, it contains all of the limitations of its respective independent claim. Independent claims 105 and 152 are patentable over the cited art and are not rejected under 103 over **Zavislan** in view of **Furler**, **Saab**, or **Choi**, and further in view of **Kittrell**.

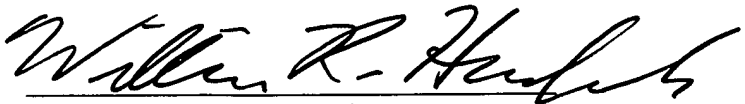
Therefore, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 108, 111, 113, 118, 119, 121, 123, 148, 150, 162, and 168 under 35 U.S.C. 103(a) as allegedly being unpatentable over **Zavislan** in view of **Furler**, **Saab**, or **Choi**, and further in view of U.S. Patent No. 5,693,043 (**Kittrell**).

Conclusion

In view of the foregoing, Applicants request reconsideration, withdrawal of all rejections, and allowance of claims 105-111, 113, 115-119, 121-126, 148, 150, 152-156, 159, 160, 162-168, 170, and 171 in due course.

If the Examiner believes that it would be helpful to discuss this application by telephone, the undersigned representative cordially invites the Examiner to call at the telephone number given below.

Respectfully submitted,



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